

### **Remarks**

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated May 14, 2004, indicated that claims 6, 7 and 9-11 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten; the Specification contains grammatical errors; claims 2, 9-11, and 14 are objected to under 37 C.F.R. § 1.75(a); claims 12-14 are rejected under 35 U.S.C. § 112(2); claims 12-14 are rejected under 35 U.S.C. § 101; claims 1, 2, 4, 5, 12 and 14 are rejected under 35 U.S.C. § 102(b) over *Sekiguchi et al.* (translation of JP 05-013306); and claims 3, 8 and 13 are rejected under 35 U.S.C. § 103(a) over *Sekiguchi et al.* in view of *Jang et al.* (U.S. Patent No. 6,043,133).

Applicant appreciates the indication of allowability for claims 6, 7 and 9-11. Applicant has amended claims 6 and 9 to include limitations of the respective underlying claims and has further amended claim 9 to improve the antecedent basis objected to by the Examiner. As such, claims 6 and 9, along with their respective dependent claims (7 and 10-11), are believed to be in condition for allowance. Applicant accordingly requests that the objections be removed.

With respect to the objection to the Specification, Applicant has amended the objected-to paragraphs to improve the grammar thereby overcoming the objection. Accordingly, Applicant requests that the objection be removed.

With respect to the objection to claims 2 and 14, Applicant has amended each of the claims to improve the antecedent basis, *e.g.*, by adding “at least one” before “extrema.” Applicant believes the objection has been overcome and requests that the objection be removed.

With respect to the § 101 rejection of claims 12-14, Applicant respectfully traverses because the claimed subject matter is patentable subject matter as acknowledged by the Patent and Trademark Office. Independent claim 12 is directed to an apparatus (stepper) having a computer readable medium (memory) which has program instructions for implementing a method. The Patent and Trademark Office, in *In re Beauregard*, acknowledged that apparatus claims directed to computer readable media used to implement computer programs or instructions are patentable subject matter. Both the claimed

apparatus, the stepper, and the claimed method implemented by the computer readable memory are patentable subject matter, thus the combination of the two is also patentable subject matter in view of *In re Beauregard*. Applicant submits that the claims are directed to patentable subject matter as acknowledged by the Patent and Trademark Office; therefore the rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

With respect to the § 112(2) rejection of claims 12-14, Applicant respectfully traverses because the claimed subject matter is clearly described and written in a form accepted by the Patent and Trademark Office. In *In re Beauregard* the Patent and Trademark Office acknowledged two claim structures acceptable for claiming computer readable media for implementing a program. Applicant's claim 12 complies with the second of these structures in that the claimed subject matter is set forth as an apparatus claim including a computer readable memory embodying program instructions executable to perform a method and including the method steps. Moreover, the Office Action further questions how the claimed alignment is achieved. The claimed alignment is achieved via the determination of a centroid of a target set. See Background section of the instant Specification. Applicant submits that independent claim 12 is properly written in an accepted format and clearly describes the subject matter claimed. Thus the § 112(2) rejection is improper and Applicant requests that the rejection be withdrawn.

Regarding the rejection of claims 1-5, 8 and 12-14, Applicant respectfully traverses and submits that the teaching in the cited *Sekiguchi* reference is far removed from the present invention that there are no issues of patentability relative thereto. To the extent that §§ 102(b) and 103(a) have been raised in the Office Action, Applicant respectfully submits that the *Sekiguchi* reference has been misinterpreted.

With respect to the prior art rejections (Section 102(b) and Section 103(a)), Applicant respectfully traverses and submits that there is no substantive relationship between the *Sekiguchi* reference and the claimed invention and that a *prima facie* case of rejection has not been presented. A prior art *prima facie* rejection of a claim requires at least a proper presentation of evidence that would allege correspondence between the cited teachings (e.g., from the *Sekiguchi* reference) and each limitation in the claims and also, for Section 103(a), a presentation of evidence of motivation to modify a reference as asserted by the Office Action. However, in connection with the §102(b) rejection, only general assertions have been made and these assertions are based on citations to the

*Sekiguchi* reference that are unrelated to the claimed invention. Claim 1, for example, is directed to a wafer having a target set formed therein. The Office Action fails to even allege that the *Sekiguchi* reference teaches such limitations. Moreover, after further review of the *Sekiguchi* reference, Applicant can find no mention therein of any target set formed in a wafer. The *Sekiguchi* reference teaches a cross-configuration mark on a mask, which fails to correspond to the claimed target set formed in the wafer. The proposed combination still fails to teach these limitations as the Office Action acknowledges at page 6 that the *Jang* reference teaches topographical marks. Without a presentation of correspondence to each of the claimed limitations, the prior art rejections cannot stand. Applicant accordingly requests that the rejections be withdrawn.

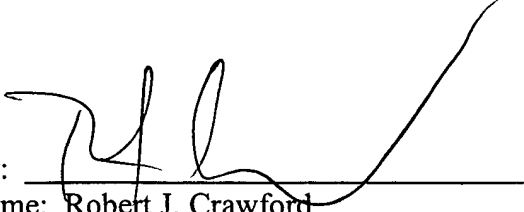
As each of the rejections is based on this apparent misinterpretation of the *Sekiguchi* reference, the rejections of each of Applicant's pending claims should be withdrawn.

Please charge deposit account No. 50-0996 (VLSI.413PA) in the amount of \$86.00 (large entity) for the additional independent claim beyond three. Additionally, authorization is hereby given to charge any additional fees or credit any overpayments that may be deemed necessary to the same deposit account number, 50-0996 (VLSI.413PA).

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Mr. Peter Zawilski, of Philips Corporation at (408) 474-9063.

*Please direct all correspondence to:*

Corporate Patent Counsel  
Philips Intellectual Property & Standards  
Mail Stop SJ41  
1109 McKay Drive  
San Jose, CA 95131

By:   
Name: Robert J. Crawford  
Reg. No.: 32,122  
(VLSI.413PA)

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